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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,031

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Hank Risan

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MEDIA RIGHTS TECHNOLOGIES C/O WAGNER BLECHER LLP
123 WESTRIDGE DRIVE
WATSONVILLE, CA 95076

EXAMINER

KIM, JUNG W

ART UNIT

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2432

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,031	Applicant(s) RISAN ET AL.	
	Examiner JUNG KIM	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/6/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are pending.
2. This Office action is in response to the amendment filed on 11/6/09.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/09 has been entered.

Response to Arguments

4. With respect to applicant's request for suggestions to overcome the 112, second paragraph rejections (see Remarks, pgs. 9-11), the following amendment is suggested: amend the limitation "Macintosh operating system" to "operating system." Note that Applicant has made a similar amendment to the claims in application no. 10/772,025, now patent 7,570,761 to avoid similar rejections of claims that had incorporated a trademark as a limitation.

Claim Rejections - 35 USC § 101

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5. The Office has instituted a new policy regarding claim interpretation under Section 101 for claims directed to computer readable medium. See

http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

6. Claims 12-22 are rejected under 35 USC 101 as being directed to nonstatutory subject matter. Claims 12-22 claim a computer readable medium. Without an explicit definition in the Specification to suggest otherwise, under the broadest reasonable interpretation a computer readable medium can be directed to signals per se. Hence, claims 12-22 are not directed to any of the four statutory categories of patent eligible subject matter. See *In re Nuijten*. To overcome the 101 rejection, add “non-transitory” as a modifier to the limitation “computer readable medium.”

Claim Rejections - 35 USC § 112

7. As per claims 1-31, the presence of the trademark “Macintosh” is not proper under 35 U.S.C. 112, second paragraph (see MPEP 2173.05(u)).

7. The trademark “Macintosh” is used in the claim as a limitation to identify or describe a particular material or product (Macintosh operating system); hence the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). To overcome the rejection, change the limitation « Macintosh operating system » to « operating system ».

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 7,316,033 in view of Doherty US 6,920,567 (hereinafter Doherty). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claims 1-31 are suggested by claims 1-27 of U.S. Patent No. 7,316,033 and Doherty.

Claims 1-27 of U.S. Patent No. 7,316,033 defines, inter alia, a method and system to prevent unauthorized recording of electronic media by

A method of preventing unauthorized recording of electronic media comprising: activating a compliance mechanism in response to receiving media content by a client system, said compliance mechanism coupled to said client system, said client system having a media content presentation application operable thereon and coupled to said compliance mechanism; controlling a data output path of said client system with said compliance mechanism by diverting a commonly used data pathway of said media player application to a controlled data pathway monitored by said compliance mechanism; and directing said media content to a custom media device coupled to

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said compliance mechanism via said data output path, for selectively restricting output of said media content. (See claim 1)

10. Doherty discloses a method and system for preventing unauthorized recording of media content on an operating system comprising:

- a. registering a compliance mechanism on a client system having said operating system operating thereon, said compliance mechanism providing stand alone functionality and operation on said client system (col. 10:24-11:20; 14:44-59; 15:55-20:29, LicMech implemented as Executable DCF or Data DCF), said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system (11:20-35, eLicense is System Locked; 13:59-14:16, "License checks"; 24:37-26:4, "Adaptive Fingerprint Security Mechanism"); and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; (10:37-38; 17:18-23 and lines 55-62; 19:55-20:3) and preventing decryption of said media content on said client system having said operating system operating thereon if a portion of said compliance mechanism is invalidated (14:1-6; 19:62-20:3, intercepts file I/O call by monitoring utility);
- b. a valid kernel level extension providing kernel level driver information to said framework; wherein when an invalid kernel level extension is recognized said framework directs said valid kernel level extension to selectively restrict output of said media content; wherein said valid kernel level extension matches no physical device on the client system (19:55-67);

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- c. wherein said framework accesses a network to ensure that said components of the compliance mechanism are up to date (13:7-15, "DeLMM");
 - d. wherein the framework establishes a monitoring thread which maintains a constant search for output devices. (11:21-36 and lines 46-54; 24:37-26:4, Adaptive Fingerprint)
 - e. wherein said multimedia component is a media rendering or processing application (14:60-15:11);
 - f. wherein said media content is received from a source coupled with said client system, said source is from the group consisting of: a network, a personal communication device, a satellite radio feed, a cable television radio input, a set-top box, an media device, a media storage device, a media storage device inserted in a media device player, a media player application, and a media recorder application (12:35-60, "Distributor System");
 - g. altering said compliance mechanism in response to a change in a usage restriction, said usage restriction comprising a copyright restriction or licensing agreement applicable to said media content. (13:10-15; 14:13-23)
11. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to prevent access to the content when the compliance mechanism is invalid.
12. Claims 1-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 7,570,761 in view

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of Doherty. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claims 1-31 are suggested by claims 1-29 of U.S. Patent No. 7,570,761 and Doherty. Claims 1-29 of U.S. Patent No. 7,570,761 defines, inter alia, a method and system to prevent unauthorized recording of electronic media by

A method of preventing unauthorized recording of electronic media comprising: activating a compliance mechanism in response to receiving media content at a client system from a content provider providing content in a format compatible with an online media service, said compliance mechanism coupled to said client system, said client system having a media content presentation application capable of handling said media content operable thereon and coupled to said compliance mechanism; controlling a data output path carrying said media content of said client system with said compliance mechanism by diverting a commonly used data pathway of said media content presentation application to a controlled data pathway monitored by said compliance mechanism; and directing said media content to a custom media device coupled to said compliance mechanism via said data output path, for selectively restricting output of said media content. (See claim 1)

13. Doherty discloses a method and system to prevent unauthorized recording of digital information, whereby secured digital files are not unsecured when the License Function mechanism is found invalid (14:1-6; 19:62-20:3, intercepts file I/O call by monitoring utility). See also double patenting rejection under claims 1-27 of U.S. Patent No. 7,316,033 in view of Doherty (Supra). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to prevent access to the content when the compliance mechanism is invalid.

14. Claims 1-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,578,002 in view

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of Doherty. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claims 1-31 are suggested by claims 1-32 of U.S. Patent No. 7,578,002 and Doherty. Claims 1-32 of U.S. Patent No. 7,578,002 defines, inter alia, a method and system to prevent unauthorized recording of electronic media by

A method of controlling interaction of deliverable electronic media comprising: detecting a media player application operable with a computer system, said media player application for enabling said computer system to present contents of a media file; and utilizing a compliance mechanism to control an output of said media file by said media player, said compliance mechanism diverting a commonly used data pathway output of said media player application to a controlled data output pathway monitored by said compliance mechanism after said media player begins to present said contents of said media file, said compliance mechanism utilized to stop or disrupt the playing of said content of said media file at said controlled data output pathway when said playing of said content of said media file is outside of said usage restriction applicable to said media file. (See claim 1)

15. Doherty discloses a method and system to prevent unauthorized recording of digital information, whereby secured digital files are not unsecured when the License Function mechanism is found invalid (14:1-6; 19:62-20:3, intercepts file I/O call by monitoring utility). See also double patenting rejection under claims 1-27 of U.S. Patent No. 7,316,033 in view of Doherty (Supra). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to prevent access to the content when the compliance mechanism is invalid.

16. Claims 1-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 7,584,353 in view of Doherty. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because the subject matter of claims 1-31 are suggested by claims 1-25 of U.S. Patent No. 7,584,353 and Doherty. Claims 1-25 of U.S. Patent No. 7,584,353 defines, inter alia, a method and system to prevent unauthorized recording of electronic media by

A method for preventing unauthorized recording of media content, said method comprising: transmitting from a client node to an administrative node a request for delivery of an instance of media content; determining which content source of a plurality of content sources to provide delivery of said instance of media content, provided said client node is authorized to receive said instance of media content; transmitting to said client node an access key and a location of said instance of media content of said content source; transmitting from said client node to said content source a second request and said access key; in response to receiving said second request and said access key, transferring said instance of media content from said content source to said client node, said instance of media content being transferred in an unencrypted format; activating a compliance mechanism upon receiving said instance of media content, said compliance mechanism for enforcing compliance with a usage restriction applicable to said instance of media content in response to said client node receiving said instance of media content in said unencrypted format; controlling a data path of a kernel-mode media device driver of said client node with said compliance mechanism by diverting a first data pathway used by said media content present application to a second data pathway governed by said compliance mechanism; and directing every said instance of media content received at said client system in said unencrypted format from said kernel-mode media device driver to a media device driver coupled with said compliance mechanism, via said second data pathway governed by said compliance mechanism, for selectively restricting output of said instance of media content. (See claim 1)

17. Doherty discloses a method and system to prevent unauthorized recording of digital information, whereby secured digital files are not unsecured when the License Function mechanism is found invalid (14:1-6; 19:62-20:3, intercepts file I/O call by monitoring utility). See also double patenting rejection under claims 1-27 of U.S. Patent No. 7,316,033 in view of Doherty (Supra). Therefore, it would be obvious to one of

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ordinary skill in the art at the time the invention was made to prevent access to the content when the compliance mechanism is invalid.

Allowable Subject Matter

18. The subject matter of claims 1-32 are not suggested by the prior art of record. In particular, none of the prior art suggest the limitation: “utilizing said compliance mechanism to control an output of said media content by said multimedia component, said compliance mechanism diverting a commonly used data pathway output of said media component to a controlled data output pathway monitored by said compliance mechanism after said multimedia component begins to present said contents of said media content, said compliance mechanism utilized to stop or disrupt the playing of said media content at said controlled data output pathway when said playing of said media content is outside of a usage restriction applicable to said media file.” Nguyen US 6,272,283 suggesting disabling a TV output and allowing the video output to a SVGA display, but does not suggest diverting from a commonly used data pathway output to a controlled data output pathway.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/
Primary Examiner, AU 2432